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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/718,884 | 11/20/2003 | Atsushi Miyawaki | 03702/LH | 8922 |
| 1933 | 7590 | 09/20/2005 | EXAMINER | |
| FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 5TH AVE FL 16 NEW YORK, NY 10001-7708 | | | ROBINSON, MARK A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2872 | |

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

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|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/718,884 | Applicant(s) MIYAWAKI ET AL. | |
| | Examiner Mark A. Robinson | Art Unit 2872 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 7-10, 15-18 and 25-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11-14, 19-24 and 29-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>7/25/05, 2/27/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of the species shown in fig. 4 in the reply filed on 7/25/05 is acknowledged.

Applicant stated that claims 1-14,19-26 and 29-34 read on the elected species. However, claims 7-10 include plural objectives as shown in figs. 9-11. Further, claims 25 and 26 include dichroic mirrors taught in conjunction with the embodiment shown in fig. 5. Thus, claims 1-6,11-14,19-24 and 29-34 read on the elected species and will be examined as follows. The remaining claims are withdrawn from consideration as being drawn to non-elected subject matter.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United

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States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,2,33 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Zeng (US 6898458).

Zeng discloses an illumination apparatus including a white light source(180), beam splitting means(184), first(150) and second(162) wavelength selective means, and beam synthesizing means(174). Regarding claims 33 and 34, Zeng also includes optical elements for introducing light to a specimen (e.g. see abstract).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 3-6,19-24 and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zeng in view of Hirano (JP 10-090608).

Regarding claims 3-6,23 and 24, Zeng discloses the limitations of these claims as discussed above and further

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discloses an objective lens (inherent in the disclosed microscope system--see the abstract), imaging or image pickup elements(50) and image processing means(43). Zeng does not show a mirror for introducing the synthesized beam in a direction to the specimen and transmitting light from the specimen. However, this arrangement is very common and an example is shown by Hirano made of record (note semi-transmissive mirror 41). It would have been obvious to the ordinarily skilled artisan at the time of invention to include Hirano's mirror arrangement with Zeng's system as a means to selectively reflect and transmit light to and from the specimen.

Regarding claims 19-22, Zeng further shows wavelength distribution monitoring means in figs. 2,8,etc.

Regarding claims 29-32, Zeng shows multiple wavelength selective means movable in and out of the optical path in figs. 9,18,19,etc.

6. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zeng in view of Hirano as applied to claims 3-6 above and further in view of Ogino (US 2001/0009473).

Zeng does not show light amount adjusting means to adjust intensities of the light in the beams of irradiation light. However, such means are well known and an example is shown by

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Ogino (note item 104). It would have been obvious to the ordinarily skilled artisan at the time of invention to include the light amount adjusting means of Ogino in Zeng's device in order to control the amount of light irradiating the sample.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references to Iketaki and Zeng (US 6826424) show various arrangements for multi-wavelength illumination.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Robinson whose telephone number is (571) 272-2319.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn, can be reached at (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval

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(PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MR

9/16/05


MARK A. ROBINSON
PRIMARY EXAMINER